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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE NW
WASHINGTON, DC 20036

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In re Patent No. 6,255,309

Issue Date: July 3, 2001

Application No. 09/272,916

Filed: March 19, 1999

Inventor: Klaus-Juergen Pees et al

Attorney Docket No. 3335002

OFFICE OF PETITIONS

ON PETITION

This is a decision on the "PETITION FOR LATE ENTRY OF PRIORITY PAPERS AND PETITION FOR SUSPENSION OF RULES UNDER 37 CFR 1.183 AND REQUEST FOR CERTIFICATE OF CORRECTION," filed January 27, 2003. The petitions are being treated as a petition under 37 CFR 1.55(a) to accept a certified copy of the priority application after the patent has been granted and under 37 CFR 1.183 to waive the rules and accept the correction of the priority data on the front page of the above-identified patent.

The petitions considered under 37 CFR 1.55(a) and 37 CFR 1.183 are **dismissed**.

Under the statute (35 U.S.C. § 119) in effect at the time the application was filed, an applicant who wished to secure the right of priority had to comply with certain formal requirements within a time specific. If these requirements were not complied with, the right of priority was lost and cannot thereafter be asserted. Specifically, the requirements of the former statute were (a) that the applicant must file a claim for the right, (b) he or she must also file a certified copy of the original foreign application, and (c) these papers must be filed within a certain time limit. The maximum time limit specified in the statute is that the claim for priority and the priority papers had to be filed before the patent was granted, but the statute gave the Commissioner authority to set this time limit at an earlier time during the pendency of the application. If the required papers were not filed within the time limit set, a petition to accept a delayed claim for priority must be accompanied by (1) the surcharge set forth in 1.17(t) and (2) a statement that the entire delay between the date the claim was due and the date the claim was filed was unintentional. Since the certified copy of the priority document was not, as required by statute, filed in the above identified application until after the patent was granted, the petition to accept the certified copy of the priority document after the patent issued is dismissed.

While the American Inventors Protection Act of 1999 (P.L. 106-113) included specific language in section 4503 that amended 35 U.S.C. § 119, section 4508 specifically provides that those amendments apply only to applications filed 1 year after enactment; i.e., only to those applications filed on or after November 29, 2000, and, further, provides that the time period specified in 37 CFR 1.55(a)(1)(i) does not apply to an application for a design patent. Therefore, 37 CFR 1.55(a) (effective November 29, 2000) which promulgates those provisions, does not apply to the instant patent, or its application. See 65 Fed. Reg. 57024 (Sept. 20, 2000)

With respect to the concurrently filed request for Certificate of Correction, a claim to foreign priority benefits cannot be perfected via a Certificate of Correction if the requirements of 35 U.S.C. § 119 and 37 CFR 1.55 have not been satisfied in the patented application or, if applicable, its parent. See In re Van Esdonk, 187 USPQ 671 (Comm'r. Pat. 1975). As such, the request for a Certificate of Correction must also be dismissed. See MPEP 201.16.

However, a reissue was granted in Brenner v. State of Israel, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where the only ground urged was applicant's failure to file the certified copy of the original foreign application under 35 U.S.C. § 119 before the patent was granted. Under the circumstances of this case, petitioner may wish to seek relief from his predicament by way of reissue under 35 USC § 251. Id. See also 65 F.R. 57024, supra; MPEP §§ 201.16, 1402.

Since a certificate of correction will not be issued, the \$130.00 petition fee submitted is unnecessary and will be credited to Deposit Account No. 11-0345, as authorized.

This patented file is being returned to the Files Repository.

Telephone inquiries should be directed to Wan Laymon at (703) 306-5685.



Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy